



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/559,066	05/03/2006	William Kennedy	DLT-004	1402
51414	7590	01/27/2009		
GOODWIN PROCTER LLP PATENT ADMINISTRATOR 53 STATE STREET EXCHANGE PLACE BOSTON, MA 02109-2881			EXAMINER KAZMI, HANI M	
			ART UNIT 3691	PAPER NUMBER
			NOTIFICATION DATE 01/27/2009	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PatentBos@goodwinprocter.com

hmcpeake@goodwinprocter.com

glenn.williams@goodwinprocter.com

Office Action Summary

Application No.

10/559,066

Applicant(s)

KENNEDY ET AL.

Examiner

Hani Kazimi

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This application has been reviewed. Claims 1-66 are pending. The rejections cited are as stated below:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-22 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular, claims 1-22 recite in the preamble “an integrated electronic credit application, contracting and securitization system”, the body of the claim does not contain any limitations indicating the structure of the system. A system or an apparatus claim should always claim the structure or the hardware that performs the function. Applicant’s claimed limitations consist of systems (software according to the specification) that do not describe the structure of the integrated system. Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-44 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof" (emphasis added).

Claims 1-22 recite in the preamble "an integrated electronic credit application, contracting and securitization system". The body of the claims recites "a credit application information entry and application routing system...", "an eContracting system..." and "an eDocument storage system..." Therefore claims 1-22 are non-statutory because they're directed towards software, per se. It is not clear whether instructions are in executable form and therefore there is no practical application.

Claims 23-44 recite a process comprising method steps such as receiving, selectively forwarding and processing. Based on Supreme Court precedent, a proper process must be tied to another statutory class or transform underlying subject matter to a different state or thing (*In Re Bilski*; *Diamond v. Diehr*, 450 U.S. 175, 184 (1981));

Parker v. Flook, 437 U.S. 584,588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876)). Since neither of these requirements is met by the claim, the method is not considered a patent eligible process under 35 U.S.C. 101. To qualify as a statutory process, the claim should positively recite the other statutory class to which it is tied, for example by identifying the apparatus that accomplished the method steps or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. Since the steps can be accomplished without the use of another statutory class, it is considered a non-statutory process.

Examiner notes that even though the claims recite another statutory class via storing information in a database, the inclusion the step of storing findings is considered an insignificant extra-solution activity and does not impose meaningful limits on the claimed invention. The step of storing information does not impart patent-eligibility under 35 U.S.C. 101 on the claimed invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 3, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by DeFrancesco et al US Patent No. 5,878,403 A.

Claims 1, 3, 4, 23- 26, 47 and 48, DeFrancesco discloses an integrated electronic credit application, contracting and securitization system, method and program readable medium comprising the steps of receiving credit application information of an applicant; selectively forwarding said credit application to one or more funding sources for approval to provide an approved credit application; processing electronic contract information and at least some of said application information from said approved credit application to provide an electronic contract between at least said applicant and a selected one of said funding sources; storing and retrieving said electronic contract and maintaining the integrity of said at least some of said application information contained in the electronic contract thereby providing irrevocable proof of the authenticity of said electronic contract; and providing on at least one application entry and display device tracking and status information about said electronic contract (abstract, figure 1 and column 23, line 33 thru column 24, line 45).

Claims 2, 24 and 46, DeFrancesco discloses the step of providing on at least one application entry and display device an electronic contract form having at least one first data field containing at least a portion of said application information and at least one second data field for entry of electronic contract information by said applicant (column 15, line 44 thru column 16, line 13).

Claims 5, 6, 27, 28, 49 and 50, DeFrancesco discloses the step of forwarding at least said electronic contract information to said selected funding source for verification purposes and receiving a funding source verification message including funding source edits from said selected funding source (column 23, line 33 thru column 24, line 45, figure 2, and column 25, line 27 thru column 26, line 8).

Claims 7-9, 29-31 and 51-53, DeFrancesco discloses the step of preventing access to said electronic contract information by said applicant until receipt of said funding source verification message on said at least one application entry display device, and the step of providing on said on said at least one application entry display device error information associated with the processing of said electronic contract (column 24, line 46 thru column 26, line 8; column 16, lines 46-67 and column 28, lines 13-58).

Claims 11-16, 33-38 and 55-60, DeFrancesco discloses the steps of selectively forwarding said electronic contract information to another of said one or more funding sources for funding, prior to sending said electronic contract to said selected funding source for funding, printing a copy of said electronic contract on a printing device for said applicant to review, receiving and storing in a database said electronic contract for a predefined period of time, retrieving said stored electronic contract from said second storage medium and displaying said stored electronic contract having an "original" or

"copy" designation on said at least one application entry and display device (column 20, lines 37-67, column 22, line 44 thru column 24, lines 45).

Claims 17-22, 39-44 and 61-66, DeFrancesco discloses the steps of providing for at least one authorized party to the electronic contract or agent of said system and maintaining in said second storage medium user permissions data of said at least one authorized user, providing and storing electronic contract ownership information in a registry and displaying said registry on said at least one application entry and display device (column 24, line 46 thru column 26, line 8; column 16, lines 46-67 and column 28, lines 13-58).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or unobviousness.

5. Claims 10, 32 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeFrancesco et al US Patent No. 5,878,403 A in view of Norris US Patent No. 5,870,721 A.

Claims 10, 32 and 54, DeFrancesco fails to teach the step of capturing an electronic signature of at least said applicant of said electronic contract using an electronic signature device.

Norris discloses the step of capturing an electronic signature of at least said applicant of said electronic contract using an electronic signature device (figure 2, column 8, line 60 thru column 9, line 12).

It would have been obvious to one of ordinary skilled in the art at the time the Applicant's invention was made to modify the teachings of DeFrancesco to include the step of capturing an electronic signature of at least said applicant of said electronic contract using an electronic signature device, because it greatly improves the efficiency of the system by providing the user with an easy and simple way of submitting loan applications and to minimize the amount of paper documents in processing loans.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hani Kazimi whose telephone number is (571) 272-6745. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Hani M. Kazimi/

Primary Examiner, Art Unit 3691